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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,293	11/14/2003	Shane Behbahany	50481/5	1152

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EXAMINER

ALIE, GHASSEM

ART UNIT PAPER NUMBER

3724

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/713,293

Applicant(s)

BEHBAHANY, SHANE

Examiner

Ghassem Alie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/14/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*Election/Restrictions*

1. Applicant's election with traverse of Species II (Fig. 3) on 10/11/05 is acknowledged. The traversal is on the ground(s) that the restriction requirement should be withdrawn because claims 1 and 3-5 are generic to both Species I (Figs. 1-2) and II (Fig. 3) is not persuasive. Applicant's traverse is misplaced. Clearly, two Species I and II are patentably distinct from one another. Generic claims permit rejoinder of a reasonable number of claims if one or more generic claims are found to be allowable. However, applicant's independent claims are not generic. In order to be generic a claim must comprehend within its confines the organization covered in each of the species. This is not possible here. For example, one species has a square-shaped latch, slot, and recess and the other Species has a different shape of recess, latch, and slot, which houses the latch. Species I (Figs. 1 and II) cannot comprehend within its confines a single large recess on the sliding member and many threaded-like recesses on the sliding member. While the broad claims may be broad enough to encompass several species they are not generic as defined by MPEP 806.04(D). Nevertheless, if applicant states that the Species I and II are obvious variants of one another, the both Species will be considered.

The requirement is still deemed proper and is therefore made FINAL.

*Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe (2,532,981). Regarding claims 1, 4, and 5, Wolfe teaches a chain saw 1 including a chain saw bar 20 mounted to chain saw 1 via at least one mounting stud. Wolfe also teaches a sliding member 25 adjacent to a first tensioning member 40, wherein the first tensioning member biases sliding member 25 in a direction such when the apparatus is incorporated into chain saw bar 20 and mounted to chain saw 22 having a mounting stud 33, sliding member 25 is biased towards the mounting stud. Wolfe also teaches a latch 25' which is configured to be received in a recess 24', and wherein latch 25' is biased and enters recess 24' and prevent sliding member 25 from moving towards the mounting stud. Bar 20 inherently is attached to saw chain by mounting stud 33. Slider 25 when is incorporated into a chain saw bar and mounted to a chain saw having a mounting stud 33, the sliding member is biased toward the mounting stud 33. Wolfe does not expressly teach that the sliding member has a recess and the latch is received in the recess of the sliding member. Instead, Wolfe teaches that the slider has a latch which is a spring finger and is received in the recess of flange 24. See Figs. 1-5 in Wolfe. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to equip the slider with a recess and the flange with a latch in Wolfe, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. Wolfe also teaches that the latch 25' is a finger spring which inherently has an integrated biasing means. The spring and the latch are not separated in Wolfe. Wolfe does not expressly teach that the latch is adjacent to the second tensioning member and the tensioning member and the latch are separated. It should be noted that applicant admitted that the latch can be separated from the second

tensioning member or can be integral with the second tensioning member. See paragraph 11 in the specification of the instant application. In addition, spring finger 25' inherently is made of a latch and a tensioning member. The latch is defined by the tip portion of the spring 25' which enters recess 24' and the lower portion of the spring finger defines the second tensioning member.

Regarding claim 3, Wolfe teaches everything noted above including that the first tensioning member and the second tensioning member comprises springs.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe in view of Jue et al. (6,442,843), hereinafter Jue. Regarding claims 1, 4, and 5, Wolfe teaches a chain saw 1 including a chain saw bar 20 mounted to chain saw 1 via at least one mounting stud 33. Wolfe also teaches a sliding member 25 adjacent to a first tensioning member 40, wherein the first tensioning member biases sliding member 25 in a direction such when the apparatus is incorporated into chain saw bar 20 and mounted to chain saw 22 having a mounting stud, sliding member 25 is biased towards the mounting stud. Wolfe also teaches a latch 25' which is configured to be receive in a recess 24', and wherein latch 25' is biased and enters recess 24' and prevent sliding member 25 from moving towards the mounting stud. Bar 20 inherently is attached to saw chain by mounting studs 33. Slider 25 when is forced toward the mounting stud 33 it will be forced in a direction away from the mounting stud until latch 25' enters the recess 24'. See Fig. 2 in Wolfe. Wolfe does not expressly teach that the sliding member has a recess and the latch is received in the recess of the sliding member. Instead, Wolfe teaches that the slider has a latch which is a spring finger and is received in the recess of flange 24. See Figs. 1-5 in Wolfe. However, it would have

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been obvious to one having ordinary skill in the art at the time the invention was made to equip the slider with a recess and the flange with a latch in Wolfe, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. In addition, the use of a tensioning member adjacent to latch instead a latch integral with a tensioning member is well known in the art such as taught by Jue. Jue teaches a sliding member 25 having a plurality of recesses 32, 34 which receives a latch 54. The sliding member is adjacent a first tensioning member 38, wherein the first tensioning member biases the sliding member in a forward direction. Latch 54 is adjacent to a second biasing member 56 and the second tensioning member biases the latch towards the sliding member. Jue also teaches that the recesses 32, 34 of sliding member 25 are configured to receive latch 54. See Fig. 5-10 and col. 3, lines 10-67 and col. 4, lines 1-65 in Jue. It would have been obvious to a person of ordinary skill in the art to provide Wolfe's locking mechanism with the sliding member having a recess and the latch adjacent to a second tensioning member, as taught by Jue, since the locking mechanisms in Jue and Wolfe function the same and they produce the same result.

Regarding claims 2 and 6, Wolfe teaches everything noted above except that the sliding member 25 has a plurality of recesses 32, 34 formed therein that enable the sliding member to be ratcheted away from the mounting stud in a step-like fashion. However, Jue teaches everything noted above including that sliding member 25 has a plurality of recesses 32, 34 formed therein that enable the sliding member to be ratcheted away from the mounting stud in a step-like fashion. See Fig. 10 in Jue and Fig. 2 in Wolfe. It would have been obvious to a person of ordinary skill in the art to provide Wolfe's locking mechanism with

the sliding member having a plurality of recesses, as taught by Jue, in order to adjust the extension of the sliding member and the length of the cutting surface extending from the chain saw.

Regarding claim 3, Wolfe teaches everything noted above including that the first tensioning member and the second tensioning member comprises springs.

*Response to Amendment*

5. Applicant's arguments filed on 10/11/05 have been fully considered but they are not persuasive.

Applicant's argument that Wolfe does not teach that the sliding member is biased towards the mounting stud is not persuasive. Claim 1, merely recites, that the first tensioning member biases the sliding member in a direction such that when the apparatus is incorporated into a chain saw bar and mounted to a chain saw having a mounting stud, the sliding member is biased toward the mounting stud. Firstly could be defined by tip of the blade 20 where the Wolfe's sliding member 25 excluding ring 33 is defined as a sliding member. Therefore, when the first tensioning member 40 biases the sliding member 25 in the direction such that when the apparatus 25, 25' is incorporated into a chain saw bar 20 and mounted to a chain saw having a mounting stud 33, the sliding tensioning member 25 is biased towards the mounting stud 33. It should be noted that the location and the function of a mounting stud Are not defined. Therefore, the member 33 can be defined as a mounting stud. Regarding claim 5, Wolfe teaches a chain saw bar 28 mounted to chain saw via at least one mounting stud 33. The bar 28 via mounted stud 33 and the chain 22 is mounted to the chain saw.

*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Zimmermann (5,345,686), Reynolds (4,382,334), Seigneur et al. (6,061,915), Kloft (4,977,708), Ehlen et al. (3,279,508), Raczykowski (5,435,065) teach a chain saw bar tensioning apparatus.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, SEE <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (too-free).



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December 16, 2005